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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,211	12/19/2001	Douglas E. Clark	3156.1000-002	5174

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EXAMINER

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 06/12/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary	Application No.	Applicant(s)	
	10/025,211	CLARK ET AL.	
	Examiner	Art Unit	
	Ted Kavanaugh	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 2,3,13-18,26,39,41,51 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-12,19-25,27-38,40,42-50 and 52-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 2,3,13-18,26,39,41,51,58 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 11. Claims 13-18 have been included since they clearly don't read on the elected embodiment. Claim 13 reads on the embodiment shown in figure 16A. Claim 26 reads on the embodiment shown in figure 22B1 and therefore this claim has been withdrawn.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

3. Claims 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The examiner is unable to find the bottom with a expansion mechanisms for expanding the shoe longitudinally and including the slots as claimed. The bottom has expansion mechanisms for controlling the width of the shoe but not the length of the shoe. Therefore, the scope of the claim is not clear.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1,4-10,12,23,24,25,27,37,38,40,42-46,48,49,50,52-57 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6519876 (Geer et al).

Geer teaches a shoe with expansion mechanisms (see col. 29, line 65 to col. 31, line 30) substantially as claimed including a bottom (the outsole as best shown in figures 76 and 77) having an expansion mechanism (7500, 7600,7602) having a plurality of slots (best shown in figure 72A) extending laterally and longitudinally, an upper (see figures 70 and 72) having expansion mechanism (7004,7102) wherein mechanism 7102 has a plurality of slots (best shown in figure 72A), a chassis (midsole) having an upper contoured surface (see figure 2), a heel cup (see figure 2) and at least three tailors zones. Geer teaches a number of different embodiments of midsole, each of the midsoles extends under the entire foot and therefore have at least three zones (i.e. the heel, the metatarsal and the toe) as claimed. Moreover, the midsole as shown and described in figure 13 and col. 15, line 64 to col. 16, line 6 can have inserts (zones) provided for the heel, shank (arch), and forefoot (toes) areas. Regarding claim 27, the

bottom (outsole) has vertical walls (securing mechanism) that are attached to the upper, see the walls (33,34,36) as shown in figure 26. Regarding claims 6 and 43, Geer teaches the upper can be made out of leather (see col. 10, lines 20-28), and see figure 70 which shows flexible material (7004) interposed between two pieces of the upper (leather upper) at a seam (stitching as shown in figure 70). Regarding claims 7 and 44, the seam is inherently an omega seam. Regarding the waterproof, breathable liner, Geer teaches these features, see col. 10, lines 30-39, col. 23, lines 48-51 and col. 24, line 66 to col. 25, line 5. Regarding claims 50 and 57, see figure 72A which show the grooves/slots angles outwardly.

6. Claim 47 is rejected under 35 U.S.C. 102(b) as being anticipated by US 4599810 (Sacre).

Sacre teaches a shoe substantially as claimed including a bottom (12), an upper (10), a chassis (14), a waterproof breathable liner (32) and a waterproof gasket (55). Regarding the terms "slip-lasted" and "cement lasted", the method of forming the device (i.e. slip lasted and cement lasted) is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. It is well settled that the patentability of a product ordinarily can not depend on its method of being made. See In re Thorpe, 777 F.2d 695, 227 USPQ 964 (1985).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geer in view of Official Notice.

Geer teaches a shoe substantially as claimed (see the rejection above) except for the bottom having a lip and the upper and lip of the bottom joined by a line of stitching to define a welt. The examiner takes official notice that it is old and conventional in the art to provide a bottom with a lip so as to be joined to the upper by a line of stitching to define a welt. Therefore, it would have been obvious to provide the shoe of Geer with the bottom with a lip so as to be joined to the upper by a line of stitching to define a welt, to facilitate joining the elements together.

9. Claim 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 30 above, and further in view of Donnadieu '475.

Donnadieu teaches a liner for a shoe comprising an expandable region in the metatarsal and toe zones (11) and a non-expandable region in the heel zone (13), see col. 4, lines 34-35. It would have been obvious to provide the shoe of Geer with a liner having a stretchable and non-stretchable zones, as taught by Donnadieu, to ensure good heel retention. Regarding claim 32, the seam, as noted in the 102 rejection above, is inherently an omega seam.

10. Claims 11,19-22 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geer in view of US 5566475 (Donnadieu).

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Geer teaches a shoe substantially as claimed (see the rejection above) except for a liner having an expandable region and a non-expandable region. Donnadieu teaches a liner for a shoe comprising an expandable region in the metatarsal and toe zones (11) and a non-expandable region in the heel zone (13), see col. 4, lines 34-35. It would have been obvious to provide the shoe of Geer with a liner having a stretchable and non-stretchable zones, as taught by Donnadieu, to ensure good heel retention. Regarding claims 20 and 21, see fig. 77 of Geer which shows an expansion mechanism (7602) extending laterally (therefore the slots (figure 72A) for expanding the shoe longitudinally.

Conclusion

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111. Moreover, "The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06" MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

11. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9302 and After Finals to (703) 872-9303 **(FORMAL FAXES ONLY)**. If the previous Fax numbers are not working use any of the following numbers (703) 305-3579 or (703) 305-3580 or (703) 305-3590. Applicants who authorize charges to a PTO deposit account may also

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use it for filing papers that require a fee. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov .

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244. The examiner can normally be reached on 6AM - 4PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached at (703) 308-2672.

Other helpful telephone numbers are listed for applicant's benefit.

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Ted Kavanaugh
Primary Examiner
Art Unit 3728

TK
June 9, 2003